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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Ken A. Nishimura et al.

Patent Appl. No.: 10/087,386

Filed on: Mar 01, 2002

For: *An Optical Signal Multiplexer/
Demultiplexer Employing
Pseudorandom Mode Modulation*

Confirmation No.: 6282

Examiner: Tran, Dzung D.

Group Art Unit: 2633

PETITION UNDER 37 CFR §1.182

OFFICE OF PETITIONS

Director for Patents and Trademarks

P.O. Box 1450

Alexandria, Virginia 22313-4150

Dear Sir:

On October 3, 2005, Applicants mailed a Notice of Appeal, FORM PTO/SB/33, and Pre-Appeal Brief Request for Review containing remarks to the USPTO with Authorization to charge the \$500.00 fee due to Deposit Account No. 50 - 1078.

On October 18, 2005 the USPTO mailed a Notice of Panel Decision from Pre-Appeal Brief Review stating that the Request was improper, indicating "Other: IDS was filed along with Request for Pre-Appeal Brief Review."

While a Supplemental Information Disclosure Statement (IDS) was mailed to the USPTO on the same date as the Request, making of record a single U.S. patent cited in the European Search Report of the EPO counterpart application, the Request did not refer to the Supplemental IDS, nor was it based in any way on the Supplemental IDS. It should be noted that Applicant's also mailed to the USPTO, on October 3, 2005, a Statement Under 37 CFR Sec. 1.97(e) verifying that it has only recently received the European Search Report.

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During a telephone conference on November 21, 2005 between the undersigned attorney of record and Anton Fetting of the Office of Patent Legal Administration, Mr. Fetting agreed that the guidelines for the pilot program for pre-appeal brief conferences do not prohibit the filing of an IDS, or indicate that the filing of an IDS shall constitute a basis for denying such requests. See OG Notice: 12 July 2005. Mr. Fetting therefore agreed that the refusal to consider the Request in connection with the above-captioned application was improper. The OG Notice merely prohibits the filing of an after-final or proposed amendment with the request for pre-appeal brief review. It also states that "[n]o supplemental requests or arguments will be accepted." An IDS is not a "request" but a mandatory filing under 37 CFR Sec. 1.56 in the case of "material information." Moreover, Rule 56 states "[t]he Office encourages applicants to carefully examine: (1) prior art cited in search reports of a foreign patent office in a counterpart application."

Because of the delay in the prosecution of foreign counterpart applications necessarily resulting from typical filing near the end of the Paris Convention deadline, supplemental IDS documents are frequently filed late in the prosecution of the U.S. parent application. Per the OG notice regarding this pilot program, the filing of an IDS does not, and should not, automatically disqualify a Pre-Appeal Brief Request for Review. In the present case, summarily denying the Request because of the mere coincidence that it was filed in the same envelope with an independent Supplemental IDS represents an arbitrary and capricious action. Applicants should not be penalized for timely good faith compliance with the duty of disclosure under 37 CFR Sec. 1.56.

Accordingly, Applicants request that their timely filed Pre-Appeal Brief Request for Review be considered on its merits. Authorization is given to charge Deposit Account No. 50 - 1078 for the fee of \$400.00, and any additional fee, required in connection with this Petition.

Respectfully submitted,



Michael H. Jester
Attorney for Applicants
Reg. No. 28,022

12/5/05